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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,746	07/06/2001	Brian James Gingras	659/791	4594
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BRINKS HOFFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER JOLLEY, KIRSTEN	
			ART UNIT 1762	PAPER NUMBER

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,746

Applicant(s)

GINGRAS ET AL.

Examiner

Kirsten C Jolley

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-62 is/are pending in the application.
- 4a) Of the above claim(s) 49-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The Examiner notes Applicant's statement that the present application and U.S. Patent No. 6,444,214 to Cole were commonly owned at the time the invention was made. Accordingly, the 35 USC 103(a) rejections over Cole have been withdrawn. Additionally, due to Applicant's amendment to claim 1, the 35 USC 102(e) rejections over Cole et al. have also been withdrawn. A new rejection is also provided over the prior art of Deacon et al., as set forth below. Further, the Examiner notes that U.S. Patent No. 6,651,924 was printed since the final Office action, and a double patenting rejection is now made. For these reasons the finality of the prior final Office action is withdrawn and this action is made non-final, and the amendments submitted in the after-final response of February 10, 2004 have been entered.

Information Disclosure Statement

2. The information disclosure statement filed January 31, 2002 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Japanese publications JP 2-91300, JP 5-209395, and JP 6-306793 have been placed in the application file, but the information referred to therein has not been considered, and the publications have been crossed through on the corresponding PTO-1449.

Art Unit: 1762

Specification

3. The Examiner notes that on pages 1 and 14 of the specification, the application numbers should be updated as U.S. Patent Nos. if the applications have been patented, and the remaining application numbers should be indicated as --commonly owned--.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-7 and 9-48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 and 26-29 of U.S. Patent No. 6,651,924. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious for one having ordinary skill in the art to have determined the optimum speed of the web to increase efficiency, but not cause stretching or undesired breaking of the web, through routine experimentation in the absence of a showing of criticality. In addition, it would have been obvious to have perforated the web in order for convenience for the user of the product.

Response to Arguments

6. Applicant's arguments filed February 10, 2004 have been fully considered but they are not persuasive.

With respect to the rejection over WO '090 (Perini), Applicant states that the statute of 35 USC 102(a) states that a person shall be entitled to a patent unless the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent. Applicant argues that the inventor of Perini necessarily had to have performed the step of breaking the web while the web was wet, or had knowledge of the claimed step, in order to determine that the step of cutting while the web was wet was difficult or impossible. Further Applicant argues that the step of breaking the web was not patented or described in a publication because the step is absent from the disclosure of the reference and knowledge is only inferred from the fact that Perini teaches away from the step, and if the step was known to the inventor of Perini, the knowledge or use of this step appears to have been in Italy, not in the U.S.

The Examiner accepts Applicant's analysis that the knowledge or use of the claimed invention by the inventor of WO '090/Perini was in another country (Italy). However, the Examiner notes that the WO '090 reference qualifies as prior art under 35 USC 102(e). 35 USC 102(e) states that a person is entitled to a patent unless the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, *except that an international application filed under the treaty defined in section 351(a) shall*

Art Unit: 1762

have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Additionally, it is the Examiner's position that the WO '090 reference does qualify as prior art under 35 USC 102(a). WO '090 is still a publication printed before the filing date of the instant application comprising a fair teaching of an alternate embodiment to WO '090's preferred embodiment. Specifically, it is the Examiner's position that while it is not preferred to break the web in the method of WO '090 when the web is wet, because the presence of moisture or liquid impregnating the material would make the changeover difficult, it would have none-the-less been obvious to one having ordinary skill in the art to have performed breaking the web while it was wet with the expectation of achieving worse results. The negative teaching in WO '090 is still a fair teaching, and although more difficult, one skilled in the art would have had an expectation of success. There is nothing in Applicant's arguments to show that Applicant's process is any different or achieves better results than the prior art teaching of WO '090.

Additionally, the Examiner notes that WO '090 teaches perforating the web at page 7, line 4; it is the Examiner's position that perforating meets the limitation of "breaking" the wet web because even if the perforations make very small incisions, the web is necessarily broken in these perforated areas.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1762

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-7, 9-12, 14, and 16-19, and 21-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/40090 A2.

WO '090 discloses a method of making wet rolls, comprising the steps of providing a web of material, applying a wetting solution to the web to produce a wet web, and winding the wet web into rolls using a roll-forming pocket to make rolls using the apparatus illustrated in Figure 1. WO '090 teaches on page 7 that a liquid-based product which impregnates or moistens the material before forming the roll L is applied to web material N after the web material N is delivered from a perforating unit.

The Examiner acknowledges that WO '090 teaches that the web material should be "substantially dry" at the changeover zone. However, as discussed above, while it is not preferred to break the web in the method of WO '090 when the web is wet, because the presence of moisture or liquid impregnating the material would make the changeover difficult, it would have none-the-less been obvious to one having ordinary skill in the art to have performed

Art Unit: 1762

breaking the web while it was wet with the expectation of achieving worse, but still successful, results. The negative teaching in WO '090 is still a fair teaching that, although more difficult, one skilled in the art would have had an expectation of success. There is nothing in Applicant's arguments to show that Applicant's process is any different or achieves better results than the prior art teaching of WO '090. Additionally, the Examiner notes that WO '090 teaches perforating the web at page 7, line 4; it is the Examiner's position that perforating meets the limitation of "breaking" the wet web because even if the perforations make very small incisions, the web is necessarily broken in these perforated areas.

As to the speed, WO '090 lacks a teaching of the speed at which the web travels. It is the Examiner's position that the travel speed of the web is a cause-effective variable. One skilled in the art would have been motivated to maximize the travel speed in order to increase productivity and efficiency of the process, however the travel speed must not be too fast that it causes the wet web to undesirably break or stretch during rolling. It is well settled that determination of optimum values of cause effective variables such as these process parameters is within the skill of one practicing in the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980).

With respect to claim 18, the web of material in the process of WO '090 is inherently provided from a source and WO '090 teaches perforating the web at page 7, line 4. The draw of the web is controlled via roller 1. The web is positioned adjacent wetting apparatus 7, as shown in Figure 1, and wetting solution is applied to at least one side of the web to yield a wet web. The amount of wetting solution would be determined by one skilled in the art as discussed below.

Art Unit: 1762

With respect to claims 31-33 and 39, WO '090 teaches a roll forming pocket/winding cradle comprised of three rollers 1, 3, 5 (illustrated in Figure 1) to form the rolls L or "cigarettes." In the roll forming pocket of WO '090, rollers 1, 3, and 5 each contact the wet web and each rotate in the same circular direction, whereby the second roller 3 rotates in a circular direction opposite from the direction of the movement of the wet web. WO '090 teaches that after forming roll L, the web wet roll L is separated from the web and discharged from the roll forming pocket (see page 7, lines 3-13).

As to claims 2-7, 24-28, 38, and 41-46, WO '090 lacks a teaching of the add-on amount of wetting solution applied on the web in its invention. It is the Examiner's position that one having ordinary skill in the art would have been motivated to determine the optimum amount of wetting solution to be added to the substrate depending upon the desired feel and wetness of the final product and the amount that may be applied without causing the wet web to be so weak that it does not break during winding.

With respect to the speed of claims 9-11, 22, and 37, the claims are rejected for the same reasons discussed above with respect to claim 1.

As to claims 12 and 30, WO '090 teaches that preferably the roll L is coreless (page 5, lines 12-14).

As to claim 14, WO '090 teaches that the may be non-woven fabric in page 3, line 13.

As to claim 17, WO '090 teaches uniformly distributing the wetting solution in the web in col. 8, lines 15-16.

As to claims 16, 29, 36, and 48, WO '090 lacks a teaching that the method of its invention is performed in an environment that is substantially free of contamination. However,

Art Unit: 1762

the Examiner notes that WO '090 is concerned with making hygienic products comprising disinfectants or detergents as taught on page 1. It would have been obvious for one having ordinary skill in the art to have performed the process of WO '090 in a contaminant-free environment in order to ensure that the products remain sterile and free of germs and/or bacteria that would negate their utility.

With respect to claim 19, WO '090 does not teach that the web material is originally supplied on a roll and unwound. It is the Examiner's position that it would have been obvious to have supplied the web material via a wound roll because such is well known in the art in order to maintain the web material which is fed to a rolling apparatus in an orderly manner.

With respect to claims 23 and 47, WO '090 teaches that the wetting solution may comprise detergents. It is well known in the art that detergent compositions comprise salts.

As to claim 35, WO '090 does not teach that the break of step b) occurs along a line of perforation. It is the Examiner's position that it would have been obvious for one having ordinary skill in the art to have made the break in WO '090's rolling process along a perforation because the web is more easily torn in that region, and therefore is less likely to cause an uneven tear in the web.

10. Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/40090 A2 as applied to claims 1-7, 9-12, 14, 16-19, and 21-48 above, and further in view of Deacon et al. (US 4,601,938).

WO '090 is applied for the reasons discussed above. WO '090 lacks a teaching of the specifics of the web used to form its wet web, and specifically using a web comprising a wet-

Art Unit: 1762

formed basesheet or water-dispersible binder. Deacon et al. is cited as being directed to a web material which may be wetted with a cleaning composition and then rolled to form wet wipes.

See col. 7, lines 42-59 of Deacon et al. Deacon et al. teaches that the web substrate may be non-woven fabric, and preferably wet laid nonwoven fabric, in col. 3, lines 34-38. Alternatively,

Deacon et al. teaches that the fabric may comprise acrylic resin binder which is water-dispersible (col. 3, lines 57-58). It would have been obvious for one having ordinary skill in the art to have

used the web substrate taught by Deacon et al. as the web material in the process of WO '090

with the expectation of successful results since WO '090 is not limited to the web material that

may be used in its process and because Deacon et al. teaches exemplary material that may be

used in a similar wet web-forming process.

11. Claims 1-7, 9-19, and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deacon et al. (US 4,601,938).

Deacon et al. teaches in col. 7, lines 42-59, a method of impregnating a dry web substrate with a liquid wax and then a liquid cleaning composition, then passing the wet web through a perforator and a slitter, and winding the wet web in the form of a coreless roll. Perforating and slitting the wet web meet the limitation of breaking the wet web.

As to the speed, Deacon et al. lacks a teaching of the speed at which the web travels. It is the Examiner's position that the travel speed of the web is a cause-effective variable. One skilled in the art would have been motivated to maximize the travel speed in order to increase productivity and efficiency of the process, however the travel speed must not be too fast that it causes the wet web to undesirably break or stretch during rolling. It is well settled that

Art Unit: 1762

determination of optimum values of cause effective variables such as these process parameters is within the skill of one practicing in the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980).

With respect to claim 18, the web of material in the process of Deacon et al. is unwound from supply roll 11. The draw of the web is controlled via roller 11. The web is positioned adjacent wetting apparatus 22, as shown in Figure 7, and wetting solution is applied to one side of the web to yield a wet web. The amount of wetting solution would be determined by one skilled in the art as discussed below.

As to claims 2-7 and 24-28, Deacon et al. lacks a teaching of the add-on amount of wetting solution applied on the web in its invention. It is the Examiner's position that one having ordinary skill in the art would have been motivated to determine the optimum amount of wetting solution to be added to the substrate depending upon the desired feel and wetness of the final product and the amount that may be applied without causing the wet web to be so weak that it does not break during winding.

With respect to the speed of claims 9-11, and 22, the claims are rejected for the same reasons discussed above with respect to claim 1.

As to claims 13-15, Deacon et al. teaches that the web may be non-woven fabric, and preferably wet laid nonwoven fabric, in col. 3, lines 34-38. Alternatively, Deacon et al. teaches that the fabric may comprise acrylic resin binder which is water-dispersible (col. 3, lines 57-58).

As to claim 17, Deacon et al. illustrates uniformly distributing the wetting solution in Figure 7.

As to claims 16 and 29, Deacon et al. lacks a teaching that the method of its invention is performed in an environment that is substantially free of contamination. However, the Examiner

Art Unit: 1762

notes that Deacon et al. is concerned with making personal cleaning products. It would have been obvious for one having ordinary skill in the art to have performed the process of Deacon et al. in a contaminant-free environment in order to ensure that the products remain sterile and free of germs and/or bacteria that would negate their utility.

With respect to claim 23, Deacon et al. teaches that the liquid composition may comprise detergent-active agents (col. 4, lines 18-21). It is well known in the art that detergent compositions comprise salts.

12. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/40090 A2 or Deacon et al. as applied to claim 18 above, and further in view of Win et al. (US 5,667,635).

WO '090 and Deacon et al. lack a teaching of combining at least two web plies into a single web for use as the web substrate. Win et al. is cited as disclosing a web substrate for a pre-moistened wet wipe that comprises multiple plies for strength. Win et al. states that "multiple plies or sheets are brought together because multiple, low basis weight sheets will dispose more readily than a single, heavy basis sheet" (col. 1, lines 38-40). It would have been obvious for one having ordinary skill in the art to have combined multiple plies of base sheets together to form the web substrate material for use in the processes of WO '090 or Deacon et al., upon seeing the reference of Win et al., in order to form a stronger product that will more readily disperse in water.

Conclusion

Art Unit: 1762

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kcj



**MICHAEL BARR
PRIMARY EXAMINER**